

Remarks

Claim Status:

Claims 1-13 remain pending. Claim 1 is amended without prejudice.

Double-Patenting Rejection:

Claims 1-13 stand rejected on double patenting grounds over assignee's U.S. Patent No. 6,700,995. We respectfully traverse this rejection.

The Office Action has not established a *prima facie* case of obviousness for each of the claims. For example, how are claims 2-13 rejected over claims 1-15 of U.S. Patent No. 6,700,995? The Applicant is left to guess because the Office Action only comments on claim 1. And guessing denies the Applicant of a fair opportunity to respond on the record.

Moreover, claim 1 in the present application (the only claim discussed under this rejection) expressly calls out a printing process; and we do not see such an express limitation in claim 1 of the '995 patent.

We respectfully request removal of the double patenting rejection.

Art-based Rejection:

Claim 1 is rejected as being anticipated by Daly-'819. Claims 2-5 are rejected as being unpatentable over Daly-819 in view of Lawler. Claims 8-13 are apparently rejected under the reasons set forth for claims 4 and 5. *Please see* the Office Action, page 6, lines 1-2. Claims 6 and 7 are rejected as being unpatentable over Daly-819 in view of Cass.

We respectfully traverse these rejections.

Claim 1

Claim 1 recites adjusting the image in accordance with values in a first representation **utilized by** a printing process; determining values to convey a digital watermark in the adjusted image; adjusting the values in accordance with a second

representation **utilized by** the printing process; and combining the adjusted change values and the image to produce a digital watermarked image.

The claim amendments are made without prejudice and even more closely align the various values as being **utilized by** a printing process.

The cited passages (i.e., Fig. 6, Col. 3, lines 45-48, Col. 4, lines 31-30, and Col. 5, lines 1-5) are not understood to disclose such features.

Claim 1 stands ready for allowance.

Claim 8

Claim recites – in combination with other features – altering color values of an image by an amount to achieve change values, the amount includes a compensation for a variation in a relationship of an input color value and at least one of ink and dye provided by a printing process to represent the input color value.

The Office Action states that the combination recited in claim 8 is rejected as set forth in claims 4 and 5. *Please see* the Office Action on page 6, lines 1-2.

But we do not see this set of features expressly set forth in claims 4 or 5.

Thus, this rejection seems to cut against the guidance provided by the MPEP (see, e.g., MPEP 706.02(j)). For example: “[T]he examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate....”

See MPEP 706.02(j).

This is because “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” See MPEP 706.02(j).

Since each of the features of claim 8 has not been discussed on the record, the Applicant is left to guess as to the intended rejection relative to claims 4 and 5. And “guessing” denies the Applicant a fair opportunity to reply on the record.

This rejection should be removed since it fails to establish a prima facie case of obviousness.

Claim 12

Claim 12 recites – in combination with other features of the claim – receiving a representation of a variation in a relationship of an input color value and at least one of ink and dye provided by the printing process to represent the input color value.

Like claim 8 above, the Office Action states that the combination recited in claim 12 is rejected as set forth in claims 4 and 5. *Please see* the Office Action on page 6, lines 1-2.

But we do not see this set of features expressly set forth in claims 4 or 5.

Thus, Applicant is again denied a fair opportunity to respond on the record to this rejection. As such, the rejection should be removed.

Remaining Claims

We respectfully request reconsideration of the remaining dependent claims as well.

Conclusion:

We respectfully request a Notice of Allowance. In the meantime, the Examiner is respectfully invited to contact the undersigned with any questions.

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Respectfully submitted,

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